REMARKS

Claims 32-39 and 44 are pending in the present application. Claim 37 was previously withdrawn from consideration and claims 1-31, 40-43 and 45-48 were previously cancelled. By virtue of this response, claims 32-39 and 44 have been amended, new claims 49-57 have been added, and no claims have been cancelled. Accordingly, claims 32-36, 38, 39, 44 and 49-57 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Interview Summary

Applicants thank Examiner Ryckman for the helpful telephonic interview conducted on April 20, 2011 regarding the present application. The participants in the telephonic interview included Examiner Ryckman, inventor Lee Bolduc, Jeffie Kopczynski (Applicants' undersigned representative) and Catherine Liang.

The telephonic interview started with a brief discussion of Applicants' technology. Next, Examiner Ryckman and Ms. Kopczynski discussed the 35 U.S.C. § 103(a) rejection of claims 32-36, 38, 39 and 44 in view of U.S. Patent No. 5,320,630 ("Ahmed") and U.S. Patent No. 6,592,593 ("Parodi"). Examiner Ryckman indicated that as amended herein, claims 32-36, 38, 39 and 44 are not obvious in view of Ahmed in combination with Parodi. Additionally, Examiner Ryckman indicated that the subject matter of new claims 49-59 is not obvious in view of Ahmed in combination with Parodi.

Support for Claim Amendments and New Claims

Support for the claim amendments and new claims presented herein may be found throughout the specification as originally filed. The following list provides non-limiting examples of figures and passages from the specification that provide support for the indicated claim amendments and new claims:

- Amendments to claim 32: page 29, line 24 to page 30, line 2
- New claim 49: page 29, lines 10-12
- New claim 50: page 29, line 31 to page 30, line 2
- New claim 51: page 19, lines 15-26; page 28, lines 17-21; page 29, lines 6-10; page 29, line 31 to page 30, line 2; Fig. 16B
- New claims 52 & 57: page 19, lines 15-22
- New claim 53: Figs. 16A-16C
- New claim 54: page 29, line 24 to page 30, line 2
- New claim 55: page 30, lines 2-8

Applicants further note that new independent claim 56 includes elements from amended claim 32 and new claims 49-51.

Claim Rejections – 35 U.S.C. § 103

Claims 32-36, 38, 39 and 44 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,320,630 ("Ahmed") in view of U.S. Patent No. 6,592,593 ("Parodi").

As amended, independent claim 32, from which claims 33-36, 38, 39 and 44 depend, recites "[a] motor-driven tool for applying an implantation force to a helical fastener sized and configured for penetration in tissue comprising a tool body, a drive motor carried in the tool body, a driven member coupled to the drive motor, carried by the tool body and operable to apply the implantation force during operation of the drive motor, a carrier on the driven member configured to couple the fastener to the driven member to transfer the implantation force from the driven member

to the fastener, and a motor control unit carried in the tool body, coupled to the drive motor, and conditioned to operate the drive motor in phases including an initial phase operating the carrier to transfer the implantation force to the fastener under conditions that result in only partial implantation of the fastener, with a distal portion of the fastener penetrating tissue such that the distal portion is implanted into the tissue, while a proximal portion of the fastener is retained within the tool body and remains coupled to the carrier . . . ." The combination of Ahmed and Parodi does not render claims 32-36, 38, 39 and 44 obvious, at least because the combination of these references fails to result in a motor-driven tool comprising a drive motor having an initial phase including all of the features recited in independent claim 32.

Ahmed discloses a ligating instrument. (See Abstract.) During use, elastic ligating rings allegedly may be sequentially dislodged from the instrument and used to ligate multiple lesions "during a single insertion of the instrument." (See Abstract.) FIGS. 7-9, which are reproduced below and annotated for clarity, depict Ahmed's instrument in use.

First, as shown in FIG. 7, a suction force is applied through a suction channel of the instrument (10) to draw lesion tissue into an inner tubular member (25). (See col. 4, lines 8-29; col. 6, lines 58-60.)

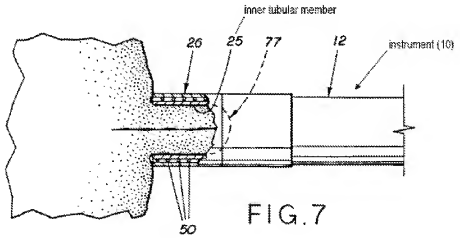

FIG. 7

Then, as shown in FIG. 8, the operator drives elastic ligating rings (50) distally "until one of the elastic rings is dislodged from the instrument and placed in ligating relation about the base of the target lesion . . . ." (See col. 6, lines 60-68.)

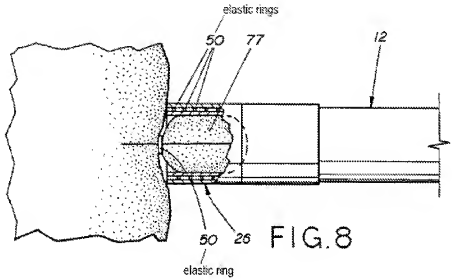

FIG. 8

Finally, FIG. 9 depicts the ligated lesion tissue after the distal end of the instrument (10) has been withdrawn from around the tissue. (See col. 6, line 68 to col. 7, line 2.)

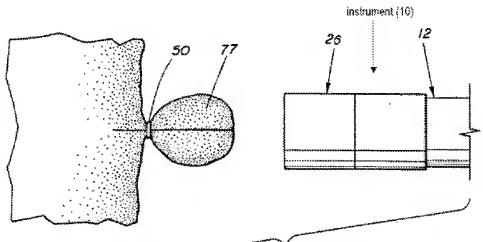

FIG. 9

At no point does Ahmed disclose or even suggest a motor-driven tool comprising a drive motor that operates in phases including an initial phase operating a carrier of the tool to transfer an implantation force to a fastener under conditions that result in only partial implantation of the fastener, with a distal portion of the fastener penetrating tissue such that the distal portion is implanted into the tissue, while a proximal portion of the fastener is retained within a tool body of the tool and remains coupled to the carrier.

First, Ahmed fails to disclose or suggest implantation of a fastener into tissue, let alone partial implantation of a fastener into tissue. Even assuming, without conceding, that Ahmed's ligating rings (50) could be considered fasteners, the rings are used to ligate or strangulate tissue, not to penetrate or implant into tissue. (See, e.g., col. 1, lines 19-22; col. 2, lines 63-68; and FIGS. 7-9.) Moreover, Ahmed does not disclose or suggest partially implanting the ligating rings into tissue. Rather, Ahmed focuses on completely dislodging one ligating ring from the instrument at a time. For example, Ahmed states:

> "It is to be appreciated . . . that the endoscopic instrument 70 provides the operator with means for precisely controlling when an elastic ring 50 is dislodged from the instrument and for insuring that only one elastic ring is dislodged when ligating a target lesion." (Col. 7, lines 47-52.)

There is no disclosure or suggestion in Ahmed of a motor-driven tool having an initial phase that may be used to partially implant a fastener, let alone to partially implant a fastener such that a distal portion of the fastener penetrates tissue and is implanted into the tissue, while a proximal portion of the fastener is retained within a tool body of the motor-driven tool and remains coupled to a carrier of the motor-driven tool.

Furthermore, Parodi, which is relied upon for its disclosure of a helical fastener, fails to cure the deficiencies of Ahmed. Even if Parodi's helical fastener were used with Ahmed's instrument, the instrument still would not operate with the phases recited in independent claim 32. Furthermore, a person of ordinary skill in the art would not have even been motivated to use

Ahmed's instrument, which sequentially deploys non-tissue-penetrating ligating rings, to partially implant Parodi's helical fastener into tissue. At least in view of the foregoing, the combination of Ahmed and Parodi does not render any of claims 32-36, 38, 39 and 44 obvious, and Applicants therefore request withdrawal of the rejection of these claims.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Additionally, any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection

with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 686732000321. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated:April 26, 2011

Respectfully submitted,

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